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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,825	12/24/2003	Akira Kinno	247194US8X	1141
22850	7590	04/17/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/743,825

Applicant(s)

KINNO ET AL.

Examiner

Laurie Ries

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/8/05, 3/16/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Original Application, filed 24 December 2003.
2. Claims 1-6 are pending. Claims 1, 5, and 6 are independent claims.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Regarding independent claim 5**, the language of this claim merely describes non-functional descriptive material. As such, this raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim that the method produces a tangible result, such as displaying the converted structured document to a user on a display device.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callahan (U.S. Publication 2002/0157023 A1) in view of Sheynblat (U.S. Patent 6,677,894 B2).

**As per independent claims 1, 5, and 6**, Callahan discloses an apparatus, program and method for converting a structured document including acquiring distribution rule information, including rules as to who may receive and view a particular file, which describe contents rules and receiver side situation information, such as a patient's assigned physician, etc (See Callahan, Page 3, paragraphs 0052-0054, and Page 5, paragraphs 0071-0072).

Callahan also discloses generating conversion rule information for converting structured documents with described content where the converting rules are based on the receiver side situation information previously acquired (See Callahan, Page 6, paragraphs 0074-0075 and paragraphs 0081-0082).

Callahan also discloses converting the structured documents on the basis of the conversion rule information (See Callahan, Page 6, paragraph 0083).

Callahan does not disclose expressly that the converting rules are based upon distribution rule information in addition to the receiver side situation information.

Sheynblat discloses that information may be sent based on distribution rules that include a user's location and the like (See Sheynblat, Column 20, lines 15-26).

Callahan and Sheynblat are analogous art because they are from the same field of endeavor of distributing information across a network.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the distribution rule information of Sheynblat in the generation of converting rules of Callahan. The motivation for this would have been to allow for the inclusion of targeted marketing, billing, etc, based on a customer's location (See Sheynblat, Column 20, lines 26-31). Therefore it would have been obvious to combine Sheynblat with Callahan for the benefit of allowing for the inclusion of targeted marketing, billing, etc, based on a customer's location to obtain the invention as specified in claims 1, 5 and 6.

**As per dependent claim 2**, Callahan and Sheynblat disclose the limitations of claim 1 as described above. Callahan also discloses that the generating includes extracting evaluation objects of the conditions includes in distribution rules and extracting receiver side situation information (See Callahan, Page 6, paragraph 0081). Callahan also discloses evaluating the conditions on the basis of the receiver side situation information extracted by the second extraction and on the basis of the results of the evaluation on the conversion rules information (See Callahan, Page 6, paragraph 0081).

**As per dependent claim 3**, Callahan and Sheynblat disclose the limitations of claim 2 as described above. Callahan also discloses that when the evaluation is a negative evaluation, such as excluding some physicians from viewing a patient's medical test record, generating the conversion rule information to delete objects corresponding to the conditions under which the evaluation has been performed from the structured document (See Callahan, Page 6, paragraph 0082).

**As per dependent claim 4**, Callahan and Sheynblat disclose the limitations of claim 2 as described above. Callahan also discloses a memory for storing the conversion rule information as created in claim 2 (See Callahan, Page 6, paragraph 0073, and Figure 1, element 106).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kobayashi (U.S. Publication 2004/0068506 A1) discloses a data distribution system, method, apparatus, server, medium and program.
- Hugh (U.S. Publication 2003/0227487 A1) discloses a method and apparatus for creating and accessing associative data structures under a shared model of categories, rules, triggers and data relationship permissions.

- Kawaguchi (U.S. Publication 2003/0103528 A1) discloses an information converting apparatus.
- Mikurak (U.S. Patent 6,606,744 B1) discloses providing collaborative installation management in a network-based supply chain environment.
- Huang discloses a semantic transcoding system to adapt Web services for users with disabilities.
- Freire discloses accessing personalized Web content and services.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

*William L Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
4/13/2006